

Applicant: Hage
Serial No.: 10/635,612
Group Art Unit: 1714

PATENT
Docket No.: 110000-9410

REMARKS/ARGUMENTS

CLAIM REJECTIONS – 35 USC § 112

Claims 3-4, 6, and 8-10 were rejected under 35 USC § 112, second paragraph as being indefinite due to improper Markush group format. These claims have been amended in accordance with the Examiner's suggestions. Withdrawal of all rejections under § 112 is respectfully requested.

CLAIM REJECTIONS – 35 USC § 102

Claims 1 and 13 were rejected under 35 USC § 102(b) as being anticipated by JP 61-017101 to *Otsuji et al.*, and also by JP 60-023092 to *Tarumi et al.* The dyes taught by *Otsuji et al.* and *Tarumi et al.* differ in many ways from the ink of the present invention:

1. The *Otsuji et al.* and *Tarumi et al.* dyes are permanent. Conversely, the ink of the present invention is removable. To make this distinction more clear, claims 1 and 13 have been amended to better reflect this difference.
2. The *Otsuji et al.* and *Tarumi et al.* dyes are transparent, only visible when viewed using ultraviolet rays. Conversely, the ink of the present invention is opaque. Because the ink is removable, there is no reason to make the ink of the present invention transparent. All of the claims have been amended to reflect this distinction as well.
3. The *Otsuji et al.* and *Tarumi et al.* dyes are heated during manufacturing to make the dye permanent. The present invention, being removable, however, there is no need to heat the dye. Hence *Otsuji et al.* and *Tarumi et al.* teach away from the present invention. That is, one skilled in the art would not look to *Otsuji et al.* or *Tarumi et al.* if faced with the task of developing a temporary, opaque ophthalmic ink.
4. The *Otsuji et al.* and *Tarumi et al.* dyes serve a different function than the ink of the present invention. The *Otsuji et al.* and *Tarumi et al.* dyes are used to provide permanent markings on a contact lens. These markings are used to convey information to an optometrist regarding the manufacturer and/or power of the lens. Because contact lenses are extremely delicate, the markings are permanent so as not to

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encourage mechanical removal of the dye. Because the markings are permanent, they must be transparent. These functional differences give rise to the aforementioned distinctions. Therefore, one skilled in the art would not look to *Otsuji et al.* or *Tarumi et al.* to create a removable ink for eyeglasses.

In light of the amendments and the arguments above, it is respectfully submitted that neither *Otsuji et al.* nor *Tarumi et al.* anticipate claims 1 and/or 13. Withdrawal of these rejections is hereby requested.

Claims 1, 10, and 13 were rejected under 35 USC § 102(b) as being anticipated by EP 472496 to *Auten et al.* *Auten et al.* teach a permanent dye applied to contact lenses with an inkjet. *Auten et al.* do not teach a removable opaque ophthalmic ink as claimed. Thus, *Auten et al.* do not anticipate claims 1, 10, and 13.

Claims 1, 10, and 13-16 were rejected under 35 USC § 102(b) as being anticipated by JP 08-112566 to *Kojima et al.* *Kojima et al.* teach a permanent dye applied to contact lenses with an inkjet. *Kojima et al.* do not teach a removable opaque ophthalmic ink as claimed. Thus, *Kojima et al.* do not anticipate claims 1, 10, and 13-16.

Claims 1, 10, and 13 were rejected under 35 USC § 102(b) as being anticipated by U.S. 5,352,245 to *Su et al.* *Su et al.* teach a permanent uniform coating for a contact lens. *Su et al.* do not teach a removable opaque ophthalmic ink as claimed. Thus, *Su et al.* do not anticipate claims 1, 10, and 13.

Claims 1, 9-10, were 13-16 are rejected under 35 USC § 102(e) as being anticipated by *Doshi '410*. Claims 1, and 9-16 were rejected under 35 USC § 102(e) as being anticipated by *Doshi '676*. Both *Doshi* patents relate to a permanent dye for contact lenses. Neither *Doshi* patent teaches a removable opaque ophthalmic ink for eyeglasses as claimed. Thus, neither *Doshi* patent anticipates any of the claims as amended.

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Claims 1, 10, and 13-16 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. 2003/0119943 to *Tucker et al.* *Tucker et al.* teach a permanent dye applied to contact lenses with an inkjet. *Tucker et al.* do not teach a removable opaque ophthalmic ink as claimed. Thus, *Tucker et al.* do not anticipate claims 1, 10, and 13-16

Claims 1-3, 7-9, and 14-16 were rejected under 35 USC § 102(e) as being anticipated by US 2002/0017219 to *Yamazaki et al.* *Yamazaki et al.* teach a permanent dye applied to contact lenses with an inkjet. *Yamazaki et al.* do not teach a removable opaque ophthalmic ink as claimed. Thus, *Yamazaki et al.* do not anticipate claims 1-3, 7-9, and 14-16.

The Examiner makes reference to MPEP 2111.02 to discuss whether the preamble of a claim should be construed as a limitation. The Applicant believes this issue is moot in light of the amendments made

CLAIM REJECTIONS – 35 USC § 103

Claims 2, 6, and 7-8 were rejected under 35 USC § 103(a) as being unpatentable over *Doshi '410* in view of U.S. 5,948,155 to *Yui et al.* Both *Doshi '410* and *Yui et al.* disclose permanent dyes applied with an ink jet. Thus, claims 2, 6, and 7-8 are patentable in light of the amendments made to the claims from which they depend. Additionally, as detailed in the specification of the application, these dependent claims are directed to independently patentable features.

Claims 4-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. 2002/0017219 to *Yamazaki* in view of U.S. 2003/0184629 to *Valentini et al.* Both *Yamazaki* and *Valentini et al.* disclose permanent dyes applied with an ink jet. Thus, claims 4-5 are patentable in light of the amendments made to the claims from which they depend. Additionally, as detailed in the specification of the application, these dependent claims are directed to independently patentable features.

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CONCLUSION

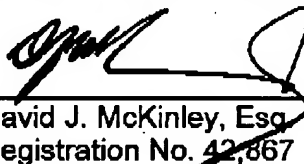
In light of the amendments made, none of the prior art cited anticipates or renders obvious, alone or in combination, the claims currently pending. Thus, it is respectfully requested that the Examiner withdraw all of the rejections and issue a notice of allowance of all claims.

If for any reason direct communication with Applicants' attorney would serve to advance prosecution of this case to finality, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-2809.

Respectfully submitted,

Dated: 8/26/05



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